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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,395	04/11/2000	Mark Wang	UCSD99-037	4506

7590 05/17/2005

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,395

Applicant(s)

WANG ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/10/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has not pointed out where the amended claims are supported, nor does there appear to be a written description of the claim limitations wherein “consisting essentially “ has been replaced with “comprising”, e.g. claim 1, line 3, or replaced with “further includes” as in claim 14, or replaced by “further comprises” as in claim 16, in respect to the medium in the application as filed. The examiner notes that “consisting essentially” has a very specific meaning as does “comprising”. The scope of what is encompassed by each is not the same. The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the

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inclusion of unspecified ingredients even in major amounts”). The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). See particularly MPEP 2111.03. By exchanging “comprised” for “consisting essentially of” applicants have broadened the scope of their claims and their original disclosure.

1. Applicant's arguments filed January 10, 2005 have been fully considered but they are not persuasive. Applicants traverse the rejection of record “for the reason that the written description, including the claims, as originally filed supports the claim changes made in Amendment C.” The evidence for this support as alleged by applicants is as follows:

a. Both claims and written description as original filed disclose a medium including significant features in addition to those defined in originally-filed claim 10. The examples cited are in dependent claim 12 as originally filed a medium is defined as “further including” an inhibitor. Applicants argue because the Examiner alleged that “including” is open-ended, that this claim 12 describes a medium having one or more additional features. The examiner does not believe this is evidence to support changing “consisting essentially” to “comprising”. The addition of “substantial elements” as the inhibitor of claim 12 is fully permissible when using “consisting essentially of” if the addition element does not materially affect the basic and novel characteristics of the claimed invention. Since claim 12 was originally present, then it must not do so. Thus, the addition of other elements is not sufficient evidence to support the proposition that a

worker of ordinary skill in the art would have understood the original disclosure to encompass the “comprising” terminology now in the instant claims.

b. “The originally-filed specification beyond the claims provides further support for a medium having significant features beside a host matrix containing a liquid monomer and a dye.” The evidence cited is (I) page 3, lines 4-5, page 8, lines 11-16, page 23, lines 2-6 for the addition of inhibitor molecules in a photopolymer, (II) page 4, lines 18-19, page 6, lines 6-9, page 7, lines 6-11, for a binder which contains the photopolymer and the dye, (III) additional photoinitiators on page 4, line 30-page 5, line 1, page 6, line 25-26. The examiner notes that these added components are to the medium and not the imaged written upon product of the medium now claimed. Further, the disclosure of these additions as optional parts of the medium originally disclosed acts to make clear that they are encompassed by the terminology of “consisting essentially of” as originally used in the claim language. These elements are used to the extent they do not materially affect the basic and novel characteristics of the claimed invention. The examiner does not see any of these passages as evidence to support the proposition that a worker of ordinary skill in the art would have understood the original disclosure to encompass the “comprising” terminology now in the instant claims.

c. Applicants point to page 5, lines 19-27, and “further include” a binder and on page 8, lines 276-29, to “permissively drawn from a large group with respect to the dye group, and page 9, lines 11-14 to a dye that photoinitiators polymerization. These elements are used to the extent they do not materially affect the basic and novel characteristics of the claimed invention. The examiner does not see any of these passages

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as evidence to support the proposition that a worker of ordinary skill in the art would have understood the original disclosure to encompass the “comprising” terminology now in the instant claims.

d. Applicants point to the “contains” language in the original claim 10 as evidence of support that workers of ordinary skill in the art would have understood applicants were extending the breadth of “comprising” by their language in the disclosure. The examiner notes that “contains” is used within a set of “consisting essentially of” thus is no longer open ended but limited by the term preceding it. There is again no overriding clear evidence of record in the original disclosure that applicants intended any other language than “consisting essentially of” when it was used. The use of open ended wording within the context of a set of components under “consisting essentially of” does not clearly destroy the meaning of “consisting essentially of”. Instead it indicates that open ended language within the meaning of not materially affecting the basic and novel characteristics of the claimed invention.

The rejection stands. Applicants have failed to present sufficient evidence to support the broadening of the claim language.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

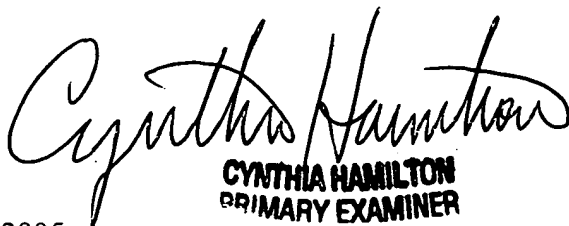
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CYNTHIA HAMILTON
PRIMARY EXAMINER

Cynthia Hamilton
Primary Examiner
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May 16, 2005